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07/718,080 06/20/91 GREGOREK

M 8089-1
EXAMINER

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26M1

ART UNIT	PAPER NUMBER
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2601

DATE MAILED:

04/29/93

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined

☒ Responsive to communication filed on 2/4/93

☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-8 and 11-15 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-8 and 11-15 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☒ The proposed drawing correction, filed on 2-4-93, has been ☒ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

1. The drawing change proposal has been approved. However, it is belatedly noted that the drawings are objectionable for failure to show a claimed element, as indicated below.

The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "video terminal" of claim 7, line 3 must be shown or the feature cancelled from the claim. No new matter should be entered. If applicants intend to add the claimed feature to the drawings, another proposal showing how that would be done would be required.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The specification is objectionable for an obvious misdescriptiveness at page 4, lines 24-26, to wit,

The switch 18 transmits the call initiated by the calling party over the telephone network 19 to an identified called party at a second telephone 20. The called party is identified by the telephone number entered by the calling party at the first telephone 12."

As was very old and well known in the art, an initial call attempt does not result in the call being transmitted to the identified called party; rather, in normal operation (which is what applicants are describing, in view of the first sentence of the paragraph), the call attempt results in the switching office testing the called-station line for its busy/idle condition, and if the line is idle, a ringing signal is applied to the line, following which, if a person or machine answers the phone or otherwise effects an off-hook condition at the station, then the call will be cut-through to the called station. Of course, if the called station is in use, a busy condition would be detected, and the call then would not be transmitted in any form to the called station. Furthermore, even assuming an idle condition at

the called station, the call would not be transmitted to the called party, but only to a called station. Absent some special calling-signal arrangements (not disclosed or suggested by applicants), a normal called telephone number input by a caller does not identify a called party, but only his or her station. Note that claim 1, lines 9-11 is misdescriptive in the same manner. The above obvious inaccuracies aside, the first sentence quoted above implies that the switch 18 itself is responsible for transmitting a call to a called [station], whereas in the system as outlined, the station 20 is actually terminated on another switch, which as known in the art must controllably effect transmission of the call to the called [station]. It is suggested that the obviousness inaccuracies could be corrected by changing "to" in 26 of page 4 to ---toward---, and changing "party" in each of lines 26 and 27 to ---station---. Of course, lines 9-11 of claim 1 also obviously need appropriate amendments.

Appropriate corrections are required.

4. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description and enabling disclosure of certain aspects of the claimed invention.

As noted in Section 6 below, the claims are indefinite. However, to the extent they can be understood, certain aspects are found to lack support.

The following phrase at lines 18-19 of claim 1 is found to lack support:

"said playing means acting independently of the particular called party;" (emphasis added).

This characterization is not found in the original text, and furthermore is found to be inaccurate. Contrary to the implied meaning of the subject quoted passage, the actions of the "playing means" obviously are variously dependent upon actions of the called party (station): see the specification, page 12, lines 15-18; page 12, line 29 to page 13, line 5; and page 14, lines 1-8.

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Another apparently unsupported aspect of amended claim 1, at lines 20-21---obviously imported from cancelled claim 10---is the limitation,

"means for immediately completing the call to the called party [sic: station] when the called party answers the second telephone." (emphasis added).

In the first place, in the context of the specification, the called party obviously could not answer the second telephone with respect to the subject incoming call if the called station were busy, which is one of the called-party (or rather, station) conditions provided for in lines 12-13 of the claim; or rather, applicants have not described any means by which a called party may answer a (new) incoming call while the called station is already in use, much less how the call would be connected to a (busy) station in response to such an answer. To the contrary, note the specification, page 6, lines 16-25,

"The switch 22 or the ANSS 23 first determines the busy/idle status of the telephone 20. On a busy condition, the switch 22 of the ANSS 23 suspends call processing for a predetermined period of time. ... After the predetermined period of time, the switch 22 or the ANSS rechecks the busy/idle status of the telephone 20 and then communicates the status to the message generator 16." (emphasis added).

Thus, even assuming there was some provision for a busy station to answer a (new) call, if that station were to answer while the call processing was suspended, the system obviously would not be able to complete the call immediately, but rather would have to wait until the system "rechecked" the station status. Furthermore, even assuming only an idle condition for the called station, the disclosure is not found to describe any provision to ensure that the incoming call would be immediately connected to a (idle) called station that answers a call. As even the same claim itself indicates (at lines 12-14), the "determining means" checks the busy/idle status of the called station "at predetermined intervals" (emphasis added), so if the called

station were to answer at a time intermediate those intervals, an "immediate" connection obviously could not be effected, as lines 20-21 would require.

Also not found to be supported is the claim 15 requirement for "interaction means for permitting the calling party to interact with said...announcement at any time by initiating a predetermined response." (emphasis added).

In the context, "at any time" in the cited passage must be interpreted to mean at any time after the caller hears an announcement played by the "playing means". However, as the flow charts indicate (see FIG. 4), an announcement is provided at step 54, then checks a schedule listing (step 56), then a source of stored messages is accessed (presumably again), following which several other steps are performed. The examiner finds no support for any indication that a caller could "interact" with an initial announcement at any time after its initial generation. For example, there is found no provision for the caller to interact with the announcement after the called station has answered the call.

5. Claims 1-8 and 11-15 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

6. Claims 1-8 and 11-15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

The following terms lack antecedent basis: "the particular called party" (claim 1, line 19, emphasis added), "said announcements" (claim 11, emphasis added: note that parent claim defines only one announcement), and "said generated announcement" (claim 15, lines 3-4, emphasis added).

7. Claims 2 and 4 are rejected under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim. These claims define no identifiable structural distinction from parent claim 1. In fact, parent claim 1 requires, at lines 15-18, that the "playing means" would provide an announcement "during a time period when an audible call progress signal would have been produced" (emphasis added), whereby the only "call progress signal" recited in claim 1 is one that does not exist. Thus, the subject dependent claims functionally attempt to limit a feature which actually does not exist.

8. The inaccuracy and indefiniteness of the claims is such that the examiner is unable to meaningfully compare them to the prior art, whereby furthermore applicants' comments thereon in their remarks are effectively moot. However, applicants' remarks have been considered, and since certain of their arguments are seen to be inaccurate and/or irrelevant with respect to both their own disclosure and the prior art of record, the examiner will comment thereon, for guidance to applicants with respect to further prosecution. Page citations below, unless otherwise identified, are to pages of applicants' remarks with the amendment.

Applicants' comment (at page 8, lines 1-4),

"This modification of the call processing software to incorporate a prerecorded announcement is done independently of the called party." (emphasis added),

is found to be irrelevant. The only reference in the present claims to "independently" (an inaccurate reference, as noted in Section 4 above) relates to the action of the "playing means", rather than to the modification of the software.

The inaccuracy of applicants' statement (page 8, lines 14-16), that "Once the called party answers the telephone, the call is immediately completed..." is apparent in view of the discussion of related terms of the claims as addressed in Section 4 above.

Applicants' statement (page 8, lines 17-19),

"Baral et al. is primarily directed to a system for providing voice messages services and not for providing announcements *such as advertisements to the calling party.*" (underlining applicants', italics examiner's),

is irrelevant. The present claims say nothing about advertisements; they recite only an "announcement", which Baral et al. certainly provides. Furthermore, even if the claims did characterize the announcement as an advertisement, it is significant that on the one hand a claim cannot achieve patentability by the nature of an announcement (see Ex parte S, 25 JPOS 904), and anyway, Baral et al. specifically state that the announcements therein may provide any information to the calling party (see therein the sentence bridging columns 4-5).

Applicants' further statement (page 8, lines 23-25) that

"...the present invention is not in any way related to the identity of the called party nor is it related to completing the call to the called party." (emphasis added),

is in the first instance irrelevant, and in the second instance clearly inaccurate. The fact that Baral et al. (and Sleeve) describe arrangements that do provide for possible relationship to the identity of the called party (note that in Sleeve this actually is indicated to be an alternative) is irrelevant, because as is well known in patent law, elimination of an unneeded feature is normally obvious: see In re Miles (CCPA 1972), 175 USPQ 33, 37. And as for the second feature mentioned in the quoted passage, that clearly is inaccurate, in view of applicants' claim 1, lines 20-21. In fact, applicants' own subsequent statement (page 9, lines 2-4) is inconsistent with the above statement.

The following statements contend that the present invention is significantly distinguishable from Baral et al., to wit (page 9, lines 9-11 and 18-21, respectively),

"The present invention checks the busy/idle status at predetermined intervals while the system is playing announcements to the calling party." (emphasis added),

"The Baral et al. system does not continually check the busy/idle status of the called party's phone and later connect the calling party to the called party if the status of the called party phone changes." (underlining applicants', italics examiner's).

In the first place, a continuous "check" is not consistent with checking "at predetermined intervals", so applicants' arguments are inconsistent. As for "checking the busy/idle status", Baral et al. clearly does that. And as for the "predetermined intervals" of status checking, that was an old and well known feature of modern telephone exchanges, known as "line scanning", which inherently does involve checking at predetermined intervals: see an enclosed article of Jayachandra. Moreover, applicants have acknowledged that the busy/idle status checking is well known: see the text, page 5, lines 2-8. Baral et al. do not specifically describe providing an announcement for the idle condition of the called party, but Sleevi, in a system with clearly comparable objectives (providing messages to callers who have not reached the called party), does clearly motivate that aspect: see therein column 6, lines 44-59.

Applicants' statement (in the sentence bridging pages 11-12) that "The present invention is a passive system which...does not itself affect the ultimate outcome of where the call is directed." clearly is inaccurate: see the specification, page 16, line 28 to page 17, line 21, and page 18, line 17 to page 19, line 6.

At page 13, lines 1-5, applicants state that

"Contrary, [sic] to the Examiner's assertion with respect to claim 7, the video terminal as recited in claim 7

is intended to relate to providing visual advertisements on a video phone or a similar piece of hardware, such as a combination television/telephone." (emphasis added),

which clearly reads into the claim limitations that are not recited therein. None of the claims of record say anything about "advertisements", and even if they did, that is specifically disclosed by Sleevi, and anyway is well within the scope of Baral et al., as noted. As for "video phone" and "combination television/telephone", no such terms are in claim 7, nor in fact does applicants' specification contain any such specific suggestions. Applicants' only reference to "video" is found at page 9, lines 26-33, which refer to a "video card" and "the calling party [having] a communication system having video capabilities", which language certainly applies to the cited teaching of Sleevi (column 7, lines 19-20 thereof), and also to the clearly relevant teaching of Segre-Amar as noted (column 2, lines 18-23; column 8, lines 9-15; and column 9, lines 52-55 therein). Applicants' suggestion (Remarks, page 13, lines 5-8) that their invention does not involve a modem is not understood, since the mentioned "video card" would have been recognized in the art as requiring a modem, and anyway, nothing in the subject claim would preclude use of a modem.

At page 13, lines 20-22, applicants state,

"Contrary to the present invention, the Sleevi reference does not address the situation where a busy signal is detected for the called party."

In this context, note that applicants are not found to disclose how the system might complete a call to a called party when the called party answers his or her telephone (a requirement of claim 1, lines 20-21) if the called station was in a busy condition, as discussed in detail in Section 4 above.

On pages 14 and 15, applicants argue that the examiner has used impermissible hindsight in making his rejections. In the first place, applicants' arguments (which, as noted are variously inaccurate and/or irrelevant) are speculative, since the present claims are considerably different from those to which the art rejections were applied. Original claims 1-5, 10, 12-14 and 15 were properly rejected under 35 U.S.C. 102(b), and clearly in no sense involved anything that might be characterized as "hindsight", and the obviousness rejections of original claims 6-9 and 11 clearly involved only such "hindsight" as is permitted in patent law (see In re McLaughlin, CCPA 1971, 170 USPQ 209). As the McLaughlin decision also indicates, the test for combining references is not what the individual references themselves suggest, but rather what the combination of disclosures taken as a whole would have suggested to one of ordinary skill in the art. The examiner submits that the claims of record discussed above, to the extent supported and understood, are not found to represent any combinations that would not be either anticipated by or obvious over the prior art of record. Finally, note anyway that claims that cannot be properly interpreted in view of 35 U.S.C. 112 cannot be meaningfully compared to the prior art: see In re Steele, Mills, and Leis (CCPA 1962), 134 USPQ 292.

9. Applicants' arguments (at pages 10-11) regarding their claim 6 are persuasive, in view of which, if parent claim 1 can be rendered accurate and definite, and the limitation of claim 6 also incorporated therein, such a resulting combination may be found unpatentable over the prior art of record.

10. Because some issues herein could have been but were not raised in the first Office action, this action is not being made final. However, the case should be prepared for final action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas W. Brown whose telephone number is (703)305-4733. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-4750.



THOMAS W. BROWN
PRIMARY EXAMINER
GROUP 261

TWBrown
April 24, 1993